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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/809,699	03/27/97	RIECHERS H	45281

12M1/0121  
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EXAMINER  
KIFLE, B

ART UNIT PAPER NUMBER  
1202 5

DATE MAILED: 01/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/809,699

Applicant(s)

Riechers et al.

Examiner

Bruck Kifle

Group Art Unit

1202

☒ Responsive to communication(s) filed on Oct 14, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-11 are pending in this application.

***Election/Restriction***

Applicant's election with traverse of group II (compounds of formula I, when X is CR<sup>14</sup> and CR<sup>14</sup> does not form an additional ring with CR<sup>3</sup>) in Paper No. 4 is acknowledged. Applicants were further required to elect a single species to which the claim shall be restricted if the generic claim is finally held to be allowable however, applicants did not comply with the election of species part of the restriction requirement. The traversal is on the ground that there exists a special technical feature in the R<sup>6</sup>-Z-C(R<sup>4</sup>)(R<sup>5</sup>)- moiety. This is not found persuasive because "the special technical feature" applicants' point to has only a carbon atom that is a constant; R<sup>6</sup> and Z are variables along with R<sup>5</sup> and R<sup>6</sup> that can be phenyl or naphthyl. Therefore, the compounds represented by formula (I) lack the same or corresponding special technical features because contrary to applicant' assertion compounds of formula I do not possess single structural element that is shared by all of the alternatives.

The requirement is still deemed proper and is therefore made FINAL.

The claims have been examined only to the extent reading on the elected subject matter.

***Claim Rejections - 35 USC § 112***

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- i) The phrase "A carboxylic acid derivative" is indefinite because one cannot say what the metes and bounds of such a derivative is. All of the compounds are not carboxylic acids. It is suggested to rewrite the claims as "A compound of formula I wherein ..."
- ii) Z is defined as sulfur, oxygen, -SO- or -SO<sub>2</sub>- (see amendment) but a proviso is present stating "... R<sup>6</sup> can be hydrogen only when Z is not a single bond" excluding compounds not embraced by the claims in the first place (Z is never a single bond). What is the purpose of the proviso? A clarification is required.
- iii) In claim 1, in the definition of R, the language "a radical which can be hydrolyzed to COOH" is indefinite. The metes and bounds of such a radical are not known.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(a) as being anticipated by Riechers et al. (J. Med. Chem. (1996), 39(11), 2123-8).

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Raschack et al. (J. Cardiovasc. Pharmacol. (1995), 26(Suppl. 3), S397-S399).

Note the different inventive entities.

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Applicant cannot rely upon the foreign priority papers to overcome this rejection because a certified translation of said papers has not been made of record. See MPEP § 201.15.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. (DE 43 13 412). The reference teaches a group of structurally similar compounds (see pages 2-4). Further, actual species that were made are disclosed in Table 2 (see pages 19-20). The claims differ from the reference species by requiring R<sup>5</sup> of the instant claims to be phenyl over methyl of species numbers 2.5-2.18, 2.31 and 2.32 of table 2 of the reference. However, the reference teaches the equivalence of methyl and phenyl in the definition of R<sup>5</sup> (see top of page 4). Therefore, one skilled in the art would be motivated to modify the reference compounds by changing the methyl group of, say species number 2.14, to phenyl and arrive at the instant claims because the reference teaches the equivalence of methyl and phenyl.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. (DE 43 13 413). The reference teaches species wherein R<sup>5</sup> is isopropyl (see 9th species on table on page 11) and the equivalence of isopropyl and phenyl in the definition of R<sup>5</sup> (see page 4, lines 31-32). Therefore, one skilled in the art would be motivated to modify the reference

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compounds by changing the isopropyl group of the 9th species in the table on page 11 to phenyl and arrive at the instant claims because the reference teaches the equivalence of isopropyl and phenyl.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.


The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [mukund.shah@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Bruck Kifle

January 14, 1998

  
MUKUND J. SHAH  
SUPERVISORY PATENT EXAMINER  
GROUP 1200